

Remarks

Applicant has amended claims 1-4, 7-8, 12-14, and 16-20, and added new claims 21-23. Entry of the Amendment and favorable consideration thereof is earnestly requested.

Rejection under §112

The Examiner has rejected claims 1-7 and 14 under 35 U.S.C. §112 second paragraph as indefinite. Claims 1 and 2 have been amended to more particular point out and describe the invention. Claims 7 is amended to more particularly point out and describe the invention, particularly addressing the Examiner's concern regarding what structure of the figure is encompassed by the language of original claim 7. Applicant has amended claim 7 to include structural language of "at least one modified surface." New claim 22 depends from claim 7 and also includes this structural element. Claim 14 has been amended to correct an informality and provide proper antecedent basis.

Claims 1, 8, 12, 13, 15 and 16 – 102(b) Hay et al.

The Examiner has rejected claims 1, 8, 12, 13, 15 and 16 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,834,371 to Hay et al. Applicant respectfully disagrees that Hay et al. discloses or suggests the present claims.

The Examiner cites Hay et al. for teaching a toy comprising a figure having a hole disposed in a portion thereof, among other things. Specifically, the Examiner references "the hole in the support 9 or 10 of the piece 3" as teaching Applicants claim element of a figure having a hole disposed in a portion thereof. Hay et al. teaches the magnet of the piece is located "below or in" the support (feet) of the piece (col. 3, lines 18-19). What the Examiner has referenced as a "hole" is where the supports 9 receive the magnet 13. (See Hay et al. Figs. 3 & 6). Nowhere in Hay et al. is there a

teaching or suggestion to provide a hole **passing through** a portion of the figure for removably receiving an accessory as is required by Applicant's independent claim 1 as currently amended. Applicant's hole passes completely through a portion of the figure, as is supported by the specification and drawings. Specifically, Paragraphs 27 and 35 of the Application, state that "accessories such as jewelry, ribbons, or other material can be threaded or **passed through** holes in various body parts of the figure."

Figures 2-5 show that the hole passes completely through the portion of the figure, the portion shown specifically here to be the ear. Therefore, the accessory can pass all the way through the hole. Clearly, the "hole" in Hay, where the support receives the magnet, does not disclose Applicant's hole **passing through** a portion of the figure for removably receiving an accessory. For at least this reason Hay et al. does not teach or suggest Applicant's claims which include this element, namely claims 1-7, 16-17, and 21-22.

In rejecting claim 8, the Examiner cites Hay et al. for teaching at least one ferrous portion (8). Applicant respectfully disagrees as Hay does not teach or suggest Applicant's independent claim 8, as amended herein, includes the limitation of at least one ferrous portion **embedded completely inside said figure**. Dependent claims 9-20 and 23 also include this limitation. Support for this amendment is found in Applicant's specification 37 and 38 and Figures 7 & 8. Figure 7 shows in ferrous portions 124, 126 embedded completely within portion of figure 100, specifically, ferrous portion 124 embedded within foot 108, and ferrous portion 126 embedded in shoe 118. (Paragraph 37 states: "Ferrous portion 124 is shown disposed in at least one foot 108 of figure 100. Ferrous portion 126 is shown disposed in at least one shoe 108 of figure 100 where shoe 108 may be permanently affixed or removably attached to foot 108.") As Figure 8 only shows the exterior of figure 100, embedded ferrous portions 124, 126 are not visible.

In contrast, Hay et al. teaches: "two supports 9 and 10 intended for contact with the game board 2, said supports being the feet of the figure....The magnet of the piece is located below or in the support 9." (Hay et al. col. 3, lines 15-18) While the magnet of Hay et al. is located at the foot of the piece, it does not teach or suggest at least one ferrous portion embedded completely inside said figure. In fact Hay et al. teaches away from embedding a ferrous portion completely inside a figure as the magnet of Hay et al. is disclosed to be in the external to the support of the piece as it must contact the game board. For at least these reasons, Hay does not disclose claim 8 as amended and any of its dependent claims, claims 9-20 and 23.

Claim 14 – 103(a) Hay

The Examiner has rejected claim 14 under 35 U.S.C. §103(a) as unpatentable over Hay stating that Hay does not teach shoes removably attached to each foot, but that it merely involves constructing a formerly integral structure into various elements which would be obvious to one of skill in the art. Applicant respectfully disagrees. Hay teaches the magnet of the piece is located "below or in" the support of the piece (col. 3, lines 18-19). The magnet of Hay et al. is disclosed to be in the external to the support of the piece as it must contact the game board. Applicant's claim 14 further contains the element that the ferrous portion is disposed in at least one of the shoes which are removably attached to feet. As the shoe is attached to the foot, the ferrous portion is inside said toy and not externally contacting the stage. Clearly, Hay et al. does not suggest claim 14.

Hay et al. discloses a game having at least two pieces movable on a game board, with the goal of the invention to provide a sports game having a greater number of pieces with good movability. (Hay et al. col. 1, lines 35-37). Hay et al. does not allow movement of a portion of its piece in relation to the rest of the piece. As such, Hay et al. does not teach or suggest the at least one ferrous portion allowing moving said

portion in relation to said figure which is an element of the present invention as set forth in new claim 23. Support for this element can be found in the specification at ¶37 which states: Various portions and body parts of figure 100, such as hands, legs, head, and the like, may have ferrous material or may receive accessories including ferrous portions in order to achieve animation of that body part or of the figure through that body part by the manipulator 120, as will be discussed below. Additionally, ferrous portions of figure 100 may serve as an attachment means for magnetic accessories. (See Application paragraph 37.)

Claims 19 and 20 – 103(a) Hay et al. in view of Hastey

The Examiner has rejected claims 19 and 20 as unpatentable over Hay et al. in view of Hastey. For the reason stated above, Hay et al. does not teach or suggest all claim elements (including the element of at least one ferrous portion embedded completely inside said figure) of claims 19 and 20, claims which are dependent of claim 8. Likewise, Hastey fails to teach these deficient elements and as such the present claims are patentable over Hay et al. in view of Hastey. Specifically, the Examiner states it would have been obvious to use the storage box of Hastey for the toy of Hay for the purpose of packaging the toy. Applicant respectfully disagrees. Applicants claims 19 and 20 include the element of the stage which provides an animation surface for the figure on one side and a storage box for the figure and the manipulator (claim 20) and also the at least one accessory (claim 20) on the other side. The box in Hastey has one purpose, to provide a display, so that the doll may be poised within and provide a more creative appearance for aesthetic or sales display purposes. (Hastey col 2, lines 12-16; col. 5, lines 35-40) Hastey's box allows for display, not (concealed) storage, of doll and it would not be a motivation to combine it with the game of Hay et al. for purposes of packaging. And even if there were motivation to use a display means to provide storage, one would not arrive at the present invention which has a

stage that also serves as a storage box for the toy. The box of Hasteley would simply hold the game, including gameboard and pieces of Hay and not meet all the elements of Applicant's claims to render such obvious to one of skill in the art.

Claims 8 and 18 – 102(b) Goldfarb

The Examiner has rejected claim 8 and 18 under 35 U.S.C. §102(b) as anticipated by Goldfarb. Applicant respectfully disagrees that Goldfarb discloses all elements of amended claim 8 and its dependent claim 18.

In rejecting claim 8 and 18, the Examiner cites Goldfarb for teaching at least one ferrous portion (44). Applicant respectfully disagrees as Goldfarb does not teach or suggest the element of at least one ferrous portion **embedded completely inside said figure** in Applicant's claim 8. In contrast, the magnets 44 in Goldfarb are mounted in a plastic disc at the base of the doll 30. (See Goldfarb col. 3, lines 39-41) Magnets 44 are held within recesses by adhesives or an otherwise snug-fitting engagement. (See Goldfarb col 3, lines 58-60) Goldfarb discloses retaining magnets in recesses with an adhesive or the like, and does not teach or suggest at least one ferrous portion embedded completely inside the figure. For at least this reason, claim 8 and all of its dependent claims, including claim 18 are patentable over Goldfarb.

Claims 9, 10 and 11 – Goldfarb in view of Kane/Woolington

The Examiner has rejected claim 9 as unpatentable over Goldfarb in view of Kane. As discussed above, Goldfarb does not disclose at least one ferrous portion embedded completely inside the figure. The disclosure in Kane does not teach this element to remedy the defects in the teachings of Goldfarb. The magnets 58, 68 in Kane are located in brackets and includes an exposed surface 196 (as shown in Figure 33). (See Kane page 17, last full paragraph). Kane does not teach or suggest at least

one ferrous portion embedded completely inside the figure. For at least this reason, claim 9 is patentable over Goldfarb in view of Kane.

The Examiner has rejected claims 10 and 11 as unpatentable over Goldfarb in view of Woolington. As discussed above, Goldfarb does not disclose at least one ferrous portion embedded completely inside the figure. Woolington, a motorized talking doll, does not mention magnets and cannot remedy the defects in the teachings of Goldfarb. For at least these reasons, claims 9 and 10 are patentable over Goldfarb in view of Woolington.

Claims 2 and 4 – 103(a) Parson in view of Woolington

The Examiner has rejected claims 2 and 4 under 25 U.S.C. 103(a) as unpatentable over Parsons in view of Woolington. As amended herein, claims 2 and 4 include the element of a hole **passing through** a portion of the figure for removably receiving an accessory, and claim 4 further includes the element of at least one ferrous portion embedded completely inside said figure.

There is no disclosure found in Parsons or in Woolington of such a hole passing through a portion of the figure. Further, while Parsons includes pieces of ferrous metals in the hands of the doll, these ferrous metals are "exposed" to allow "direct contact [of metal objects] with the exposed surface D of the magnet." See Parsons col. 1, lines 35-36. Parsons states that "it is desirable that the surface of the magnet shall be arranged in such a manner as to contact as directly as possible with the metals to be attracted and held thereby." (Parsons col. 2, lines 43-47.) As such, Parsons teaches away from a ferrous portion embedded completely inside said figure. Woolington, a motorized talking doll, does not mention magnets and cannot remedy the defects in the teachings of Parsons. Neither Parsons nor Woolington, alone and/or in combination disclose or suggest all elements of claims 2 and 4 and do not render the present claims obvious.

Claims 2, 3 5-7 103(a) Unalp in view of Ware


The Examiner has rejected claims 2, 3, and 5-7 as being unpatentable over Unalp in view of Ware. The Ware reference is not listed on the Notice of References Cited nor is any patent number for Ware referenced within the Examiner's Detailed Action.

The Examiner cites Unalp for teaching all claim elements except for a plush teddy bear figure. Applicant respectfully disagrees. Unalp discloses a doll with a concealed sticker dispenser and a plurality of cooperating stamp elements. (See Unalp, col. 8, lines 50-51) The doll has "an ear 17 having a aperture 18 formed in the earlobe thereof." (See Unalp, col. 3, lines 9-10), which is described as follows: "Earring 30 further includes a resilient embossed stamp 33 supported upon base 31 and closure cap 34 which is removably securable to embossed stamp 33 and base 31. (See Unalp. Col. 3, lines 14-21) Unalp states that the post 32 of an earring is receivable within aperture 18. (See Unalp col. 3, lines 16-17) . The aperture is not disclosed as passing through the ear of the doll, nor is it stated that the earring could go through the aperture or through the ear of the doll. Therefore, while the disclosure in Unalp includes an aperture in the ear, it does not disclose the element of a hole **passing through** a portion of the figure for removably receiving an accessory, as recited in independent claim 2 and all of its dependent claims. As the Examiner cites the Ware reference as disclosing a plush teddy bear figure, it cannot remedy the deficiencies in Unalp. For at least these reasons, claims 2 and 4 are patentable over Unalp alone and/or in combination of Ware.

The aforementioned amendments and remarks show claims 1-23 to be patentable over the references cited by the Examiner, and all rejections are respectfully traversed. It is respectfully submitted that all of the claims in the application are in

order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. Whitmyer, Jr.', with a stylized flourish at the end.

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